

REMARKS

The above-referenced patent application has been reviewed in light of the Office Action referenced above. Claims 1-24 are pending in this application. Claims 1, 4-7, and 11-24 are allowed, which Assignee gratefully acknowledges. Claims 2, 3, and 8-10 stand objected to and/or rejected. Claims 2, 3, and 9 stand rejected under 35 USC § 112 as being indefinite. In addition, claims 2, 3, and 9 stand objected to under 37 CFR 1.75(c) for failing to further limit the claim from which they depend. Claims 8 and 10 stand rejected under 35 USC § 102 over U.S. Patent No. 5,452,108 (hereinafter Muramatsu). Claims 1-4, 9, 17, 18, 20, and 22 are currently amended. However, these amendments merely correct minor typographical errors and do not narrow the scope of claims subject matter. For example, minor typographical errors, such as replacing a semi-colon with a coma in claim 17 and moving an inadvertently misplaced "and" in claim 20, have been corrected. For further example, claims 2, 3, 18, and 22 have been amended to include a colon after the word comprising. Furthermore, claims 2, 3, and 9 have been amended to clarify Assignee's claimed subject matter. However, Assignee respectfully asserts that these amendments do not narrow the scope of claimed subject matter. Accordingly, Assignee respectfully asserts that these amendments do not cause any prosecution history estoppel because they do not alter the scope of Assignee's claimed subject matter. No new matter has been presented. Reconsideration of the above-referenced patent application in view of the foregoing amendments and following remarks is respectfully requested.

With regard to the Examiner's rejection of, and objection to, claims 2, 3, and 9, Assignee respectfully asserts that the Examiner is mistaken in these rejections and objections. For example, the Examiner asserts that claims 2, 3, and 9 contradict their respective base claims rendering them indefinite under 35 USC § 112. The Examiner also asserts that claims 2, 3, and 9 do not further limit their respective base claims in violation of 37 CFR 1.75(c). However, Assignee respectfully asserts that the Examiner is wrong in these assertions. Claims 2, 3, and 9, as amended, and as previously presented, merely add further limitations to their respective base claims, and as such satisfy 37 CFR 1.75(c) and are not indefinite under 35 USC § 112. For example, claim 2 states

“wherein said moving said scanning head further comprises alternating between moving said scanning head in said first direction and moving said scanning head in a second direction, until said scanning head scans a plurality of portions of said paper sheet.” Assignee respectfully asserts that this language does not contradict the language of claim 1, from which claim 2 depends. On the contrary, Assignee respectfully asserts that claim 2 merely adds a further limitation on claim 1, and that as such claim 2 is not indefinite under 35 USC § 112 and satisfies 37 CFR 1.75(c). For further example, claim 3 states “wherein said moving said scanning head further comprises moving said scanning head in a second direction opposite to said first direction.” Assignee respectfully asserts that this language does not contradict the language of claim 1, from which claim 3 depends. On the contrary, Assignee respectfully asserts that claim 3 merely adds a further limitation on claim 1, and that as such claim 3 is not indefinite under 35 USC § 112 and satisfies 37 CFR 1.75(c). For further example, claim 9 states “wherein said moving said scanning head further comprises alternating between moving in said first direction and in a second direction, and wherein said second direction is opposite said first direction.” Assignee respectfully asserts that this language does not contradict the language of claim 8, from which claim 9 depends. On the contrary, Assignee respectfully asserts that claim 9 merely adds a further limitation on claim 8, and that as such claim 9 is not indefinite under 35 USC § 112 and satisfies 37 CFR 1.75(c). Accordingly, Assignee respectfully requests that the rejection under 35 USC § 112 and the objection under 37 CFR 1.75(c) be withdrawn.

With regard to the rejections of claims 8 and 10, Assignee respectfully asserts that these rejections should be withdrawn. In order to establish a prima facie case of unpatentability under 35 U.S.C. § 102, the examiner must establish that each and every aspect of the rejected claim is taught by the cited document. With respect to the merits of the specific claim rejections, we begin by discussing claim 8. Regarding claim 8, Assignee respectfully asserts that Muramatsu does not teach each and every element of claim 8. Therefore, it is respectfully asserted that the Examiner has failed to make out a prima facie case of unpatentability with regard to claim 8. Specifically, Muramatsu does not teach “moving a paper sheet a first distance at least partially onto a scanning window; scanning a portion of said paper sheet with a scanning head; moving said scanning head a second distance in a first direction, wherein said second distance is smaller than said first distance; and repeating

said scanning and said moving said second distance until said scanning head scans a plurality of the portions of said paper sheet on said scanning window,” as recited in Assignee’s claim 8. More specifically, the portions of Muramatsu cited by the examiner, column 2, lines 58-63 and Figure 10, do not even mention a paper sheet, much less moving a paper sheet as recited in Assignee’s claim 8. In light of this, it is respectfully requested that the rejection of claim 8 on this basis be withdrawn.

Claim 10 depends from claim 8 and as such patentably distinguishes from the cited document on at least the same basis as claim 8. Accordingly, Assignee respectfully requests that the rejection of claim 10 be withdrawn as well.

Although additional arguments are believed to exist for distinguishing the cited documents, the foregoing is believed sufficient to address the Examiner’s rejections. Likewise, failure of the Assignee to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of the Examiner’s position. Instead, it is believed that the Examiner’s positions are rendered moot by the foregoing and, therefore, it is believed not necessary to respond to every position taken by the Examiner with which Assignee does not agree.

CONCLUSION

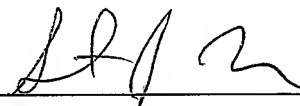
In view of the foregoing, it is respectfully submitted that all of the claims pending in this patent application are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500. Consideration of this patent application and early allowance of all the claims is respectfully requested.

Please charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account number 50-3703.

Respectfully submitted,

Dated: _____

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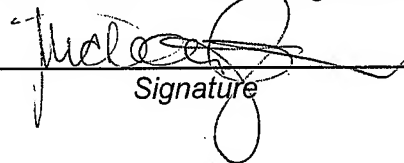
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